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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,277	12/28/1999	HIROSHI KOIKE	500-38037XOO	9791

20457 7590 11/15/2002

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EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/473,277

Applicant(s)

KOIKE ET AL.

Examiner

Jalatee Worjloh

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-32 is/are rejected.
- 7) ☒ Claim(s) 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.                      6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. This Office Action is responsive to the amendment filed on September 9, 2002, in which Applicant canceled claims 1-21 and added new claims 22-32.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 23, 28 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The steps, which go to make up the method, must be clearly and positively specified. The steps must be organized and correlated in such a manner as to present a complete operative method. That is, the method distributes to the management device digital content transmitted from the database device based on *said distribution request*, this is done before transmitting the request. How can the distribution be based on *said distribution request* if the request was not yet made.

4. Claim 23 recites the limitation "said pending device" in line 5. There is insufficient antecedent basis for this limitation in the claim.

***Claim Objections***

5. Claim 24 is objected to because of the following informalities: typographical error; change “an original contents” to “an original content”; change “a digital contents” to “a digital content” (see line 3). Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 22, 26, 29 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6226618 to Downs et al.

Downs et al. disclose a system, method, medium and program file for selecting digital contents corresponding to each of a plurality of stores selling said digital contents, and generating a distribution schedule for controlling distribution of said digital contents

Art Unit: 3621

corresponding to said stores; instructing distribution of digital contents according to said distribution schedule to each of said stores; and n for selling a particular digital content selected by a customer from said distributed digital contents (see col. 18 & col. 19, table, steps 136, 140, 141, 148).

8. Claims 25, 27 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by European Patent No. 0809221A2 to Poggio et al. et al.

Poggio et al. disclose a method, system, medium and for collecting sales information of digital contents sold to a customer (see col. 2, lines 50-53), calculating numbers of each of digital contents sold among a predetermined period based on said collected sales information of said predetermined period, calculating total number of sold digital contents for each digitized contents holder having a license for said digital contents, and sending for said digital contents holder a fee corresponding to the total number of said digital contents for each of the digital contents holder (see col. 4, lines 39-45; col. 6, lines 13-16). Note. Poggio et al. disclose a system that provides information on associated licensing fees for customer selected products. Poggio et al. do not explicitly state that the fee (i.e. "numbers") was calculated; however, the fee (i.e. "number") must have been calculated prior to providing it to the customer.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3621

10. Claim 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. as applied to claim 22 above, and further in view of US Patent No. 5799157 to Escallon and European Patent No. 0809221A2 to Poggio et al..

Escallon discloses generating a digital content by digitizing an original content (see col. 3, lines 11-15). Escallon does not expressly disclose transmitting to a recognition device a confirmation of contents of said digital contents, executing confirmation of contents for said digital contents by receiving a request of said confirmation of contents and transmitting to a digitizing device a message to indicate whether or not the contents thereof are to be recognized and receiving said message from said recognition device and indicating to accumulate the digital contents recognized by said recognition device. Poggio et al. disclose transmitting to a recognition device a confirmation of contents of said digital contents, executing confirmation of contents for said digital contents by receiving a request of said confirmation of contents and transmitting to a digitizing device a message to indicate whether or not the contents thereof are to be recognized and receiving said message from said recognition device and indicating to accumulate the digital contents recognized by said recognition device (see col. 8, lines 20-23; col. 9, line 34-55). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Escallon to include the steps of transmitting to a recognition device a confirmation of contents of said digital contents, executing confirmation of contents for said digital contents by receiving a request of said confirmation of contents and transmitting to a digitizing device a message to indicate whether or not the contents thereof are to be recognized and receiving said message from said recognition device and indicating to accumulate the digital contents recognized by said recognition device. One of

Art Unit: 3621

ordinary skill in the art would have been motivated to this because it allocates digital information within the network.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Art Unit: 3621

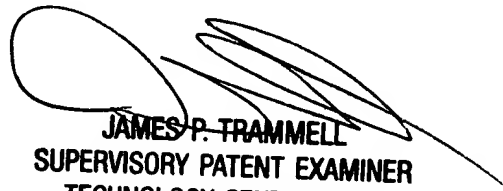
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to: **Commissioner of Patents and Trademarks, Washington, DC 20231.**

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

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November 4, 2002

  
**JAMES P. TRAMMELL**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**